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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,269	03/13/2001	Isao Suetake	1095.1169	9104

21171 7590 07/12/2005

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/804,269	SUETAKE, ISAO	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,8 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,8 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 20 April 2005 have been fully considered but they are not persuasive. The arguments are addressed at para. 6-9 below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 4, 6, 8 and 10 are rejected under 35 U.S.C. 103(a) as being obvious over Sekioka (US pat. 4836309) in view of Matsumoto et al. (US pat. 4827109).

4. Sekioka teaches a commodity sales mediation system, apparatus and method, and a recording medium, the system comprising: an *IC card* ***6*** information transfer medium storing commodity information of a commodity available for purchase by a user (col. 2 line 66 to col.3 line 7), which reads on information of a commodity purchased by a user; and an *electronic weighing instrument* commodity sales mediation apparatus comprising means for reading the purchased commodity information (*IC card reading and writing device* ***5***, col. 3 lines 23-24) and commodity information output means (*display unit* ***4***, col. 3 lines 33-34), wherein said commodity information output means outputs the presented output information through electric communication means (i.e., *display unit* ***4*** is electrically connected to *CPU* ***11*** through *display controller* ***17***, col. 2 lines 30-39 and Fig. 2). Concerning claim 10, Sekioka also teaches providing the price of the commodity based on the price per unit weight (col. 4 lines 32-35), which reads on providing additional information based on the read information (col. 4 lines 26-30).

5. Sekioka does not teach a non-contact information transfer medium. Matsumoto et al. teaches a non-contact information transfer medium (col. 2 lines 9-10). Because Matsumoto et al. teaches that a non-contact IC card is free from the deficiencies of contact-type cards

(col. 2 lines 32-34), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Matsumoto et al. to those of Sekioka.

6. Applicant argues (pp. 5-6) that the references cannot be properly combined because it would change the "principle of operation" of Sekioka. The examiner believes that this is not a correct interpretation of the pertinent case law, *In re Ratti* (MPEP § 2143.01, last section). In *Ratti*, the CCPA explicated the precept that references cannot be properly combined if to do so would change the basic principle under which the primary reference construction was designed to operate. In that case, the primary reference taught an oil seal requiring rigidity for operation, whereas the claimed invention (and therefore the combination of references) required resiliency. A change from requiring rigidity to requiring resiliency is a change in basic principle.

7. There is no change in principle, much less a change in basic principle, in the present case. Sekoika teaches a computerized scale having as a component an *IC card* ***6*** (Fig. 2). There is no specification as to whether this is a contact type or non-contact type information transfer medium. Hence the combination of references does not necessarily require any change in principle of operation of the Sekoika invention.

8. Even if Sekoika had specified a contact type card, the examiner believes that the logic of Matsumoto et al. is so compelling as to make it obvious to substitute a non-contact type card and reader for a contact type card and reader. While this would comprise a change, it is neither central nor basic to the principles under which the Sekoika invention operates.

9. Applicant argues (p. 6, first full para.) that the references are nonanalogous art. As applicant noted, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In the instant case, the combination would be compelling because it is reasonably pertinent to the particular problem with which the applicant was concerned: as taught by Matsumoto et al., the non-contact card is free from the deficiencies of the contact type card and therefore superior to the contact type card.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

13. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 until 14 July 2005, and 571-273-8300 thereafter.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15. **AFTER FINAL PRACTICE –** Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when

applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

16. Applicant may have after final arguments considered and amendments entered by filing an RCE.

17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

6 July 2005